

### **REMARKS**

Claims 16-17 and 19-33 are pending and stand rejected. Claim 15 is canceled without prejudice or disclaimer. Claim 33 is amended. Support for the amendment to claim 33 can be found, *inter alia*, at paragraph [00149] of the specification and in Figure 19. Conforming amendments have been made to claims 16, 17, 19, 21, 25, 27, 31, and 32. No new matter has been introduced.

Applicant has reviewed the Office action, including the Examiner's remarks and the references cited therein. Applicant submits that the following remarks are fully responsive to the Office action, and that all pending claims are patentable over the cited references.

### **Rejection Under 35 U.S.C. § 102**

The Examiner rejects claims 15, 17, 19-23, 25-27, and 29-33 under 35 U.S.C. § 102(b) as anticipated by United States patent no. 6,216,045 to Black et al. ("Black"). To be anticipatory, a single prior art reference must explicitly or inherently teach each and every element of the claimed invention. MPEP § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987)). As to claim 15, the rejection is moot in view of the cancellation thereof. As to the remaining claims, Applicant respectfully submits that Black fails to meet this standard.

Claim 33 recites, *inter alia*, "at least one arbitrarily-shaped electrode overmolded by a portion of the catheter, at least a portion of the at least one arbitrarily-shaped electrode being exposed through *and completely surrounded by* the overmold of the catheter[.]" (Emphasis added.) That is, the exposed portion of the arbitrarily-shaped electrode is enclosed on all sides, encompassed, or encircled by the overmold material. Put another way, the entire perimeter of the exposed portion of the arbitrarily-shaped electrode is defined by overmold material. This is illustrated, for example, in Fig. 19.

Black, on the other hand, teaches electrodes with perimeters that are at least partially defined by electrode spacer material rather than overmold material. Indeed, as

the Examiner points out in the Office action, Black teaches that the electrodes are only “*partially surrounded*” by material.<sup>1</sup> Black, col. 7:16-17 (emphasis added).

Applicant therefore submits that Black fails to teach each and every element of, and therefore cannot anticipate, claim 33. Claims 17, 19-23, 25-27, and 29-32 depend, directly or indirectly, from claim 33, and are allowable for at least the same reasons. Applicant accordingly respectfully requests reconsideration and withdrawal of the rejection under section 102(b).

### **Rejections Under 35 U.S.C. § 103**

The Examiner rejects claims 16 and 28 under 35 U.S.C. § 103 as obvious over Black. The Examiner also rejects claim 24 under 35 U.S.C. § 103 as obvious over Black in view of United States patent no. 5,125,913 to Quackenbush (“Quackenbush”). Applicant respectfully disagrees.

Though the prior art references need not teach or suggest each and every limitation of a claim for that claim to be obvious, Applicant contends that the differences between the rejected claims and the references cited are sufficiently great so as to render the claimed invention non-obvious to one of ordinary skill in the art at the time the invention was made. Examination Guidelines for Determining Obviousness Under 35 U.S.C. § 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57526, 57527-28 (Oct. 10, 2007) (“[T]he focus when making a determination of obviousness should be on what a person of ordinary skill in the pertinent art would have known at the time of the invention, and on *what such a person would have reasonably expected to have been able to do in view of that knowledge.*”) (emphasis added). In particular, Applicant contends that the cited references do not teach “at least a portion of the at least one arbitrarily-shaped electrode being exposed through and *completely surrounded* by the overmold of the catheter[.]” and thus one of

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<sup>1</sup> As discussed at length in previous responses, Applicant maintains that the material partially surrounding the electrodes of Black is not overmold material, as all overmold material is necessarily removed during the grinding operation described in Black.

ordinary skill in the art would not have learned the claimed invention from the asserted references.

Claims 16, 28, and 24 depend from claim 33. The shortcomings of Black with respect to claim 33 have been discussed at length above. These shortcomings are not addressed through the addition of Quackenbush. Accordingly, Applicant submits that the claimed invention is substantially different from, and therefore non-obvious over, the asserted references. Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 103.

**CONCLUSION**

In view of the foregoing remarks, Applicant respectfully submits that the application is in condition for allowance, and requests that all rejections be withdrawn, that all pending claims be allowed, and that the application be passed to issue. If, for any reason, the Examiner finds the application to be in other than condition for allowance, the Examiner is invited to contact the undersigned in an effort to resolve any matter still outstanding before issuing another action.

No extension of time is believed necessary for this paper to be considered timely. Should an extension of time be deemed necessary, Applicant hereby petitions therefor under 37 C.F.R. § 1.136. Authorization is hereby granted to charge any fees due with the filing of this document, including any fees for any extensions of time deemed necessary, to Deposit Account No. 50-1129 with reference to Attorney Docket No. 0B-045000US/82410-0067.

Respectfully submitted,

**WILEY REIN LLP**

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By:           /Scott A. Felder #47558/  
Scott A. Felder  
Registration No. 47,558

**WILEY REIN LLP**  
Attn: Patent Administration  
1776 K Street, N.W.  
Washington, D.C. 20006  
**Telephone: 202.719.7000**  
**Facsimile: 202.719.7049**